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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,512	10/17/2000	Eric C. Hannah	INTL-0482-US (P10030)	3230

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EXAMINER	
JANVIER, JEAN D	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/690,512	HANNAH ET AL.	
	Examiner	Art Unit	
	Jean Janvier	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17 and 19-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17 and 19-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☑ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response To Applicant's Arguments

Regarding the rejections of claims of 5, 15 and 25 under 35 USC 112(2), although the specification may support or disclose how the monitoring of the watermark helps determine the speed at which the advertisement was played, however, limitations from the specification are not directly read into the claimed invention See (*In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)). To this end, the linking or the relationship between the watermark and the speed of playing is rather premature. There should be enough claim elements recited therein so as to enable one skilled in the art understand such relationship (and the specification can be reviewed for more details if need).

In response to the Applicant's arguments, regarding the 102 Rejection, that neither the applied reference nor the Office Action teaches "associating an indication that an advertisement was played with an identifier for a particular user" as featured in claims 1 and 11, the Examiner admits that each advertisement has, by default, a unique ID, filename or identifier that uniquely identifies the advertisement in the system (at the time of download to the time of reception by the specific user). Further, each (identified) advertisement is tracked to determine whether or not it was played in its entirety before the specific user is being compensated for viewing the specific or identified advertisement. In other words, the process of "associating an identifier with an advertisement whether or not the advertisement was played" is implicitly taught or supported in the prior art. Moreover, Rodriguez supports compensating a subscriber or a specific user for each advertisement played in its entirety and thus, that advertisement must be identified before the user is compensated. To this end, the process of "associating an indication that an advertisement was played with an identifier for a particular user" in anticipated by the reference.

Additionally, Applicant argues that claim 21 calls for a watermark detector to detect a watermark included advertisement and control operation of a media player in response to detection of the watermark and such claim elements are not taught or addressed in the Office Action. However, the Examiner completely and respectfully disagrees with the Applicant's practice. Indeed, Rodriguez discloses that watermark technology is used to track and verify proper delivery of content including advertising content. **In one application of this technology, recipients of advertising content, such as TV subscribers, computer users (identified users), are provided incentives for viewing advertising in its entirety (by controlling the media player, used to play the audio advertisement file, such that the entire watermarked advertisement is heard or consumed without the user's interruption). For example, a content-receiving device, such as a computer, can include a watermark detector that issues a receipt for each watermarked advertisement that is heard/viewed in its entirety (providing accrued incentives or accumulated rewards to an identified user of a computer or a set-top-box for listening to played or viewing displayed watermarked advertisements). Here, the watermark detector, coupled to the identified user's receiving device, is operable to detect that a watermarked advertisement is entirety played/heard before issuing a compensation receipt for hearing the advertisement in its entirety. It should herein be understood that in order to play the advertisement in its entirety, the player/media player (such as a piece of software-e.g. Windows Media Player) should be configured to prevent the user's interruption of the advertisement being played once the watermark detector has detected the presence of a watermark embedded or inserted into the played advertisement**

file before a compensation receipt, related to the identified and entirely heard watermarked advertisement, can be issued.

(Col. 44: 17 to col. 45: 22; col. 24: 23-37; col. 54: 26-54; col. 55: 35 to col. 56: 19; col. 57: 9 to col. 58: 34).

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Applicant's arguments as herein presented are not plausible and thus, the last Office Action, as shown below, is hereby maintained and the current **Office Action has been made Final.**

DETAILED ACTION

Specification

Status of the claims

Claims 1-17 and 19-30 are currently pending in the Instant Application and claim 18 was canceled by the present amendment.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 5, 15 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 5, 15 and 25, it is unclear how the watermark can help determine the speed at which the advertisement was played. In other words, important elements necessary for the understanding of the claim language are omitted therefrom. Thus, The claim will be broadly interpreted.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-17 and 19-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Rodriguez, US Patent 6,650, 761 B1

As per claims 1-17 and 19-30, Rodriguez discloses, inter alia, a system for watermarking content, such as a downloaded video or a transmitted advertisement, to thereby guarantee integrity of the downloaded content or transmitted advertisement upon receipt and to correctly

bill the recipient of the video content for what was actually received as opposed to what was transmitted or downloaded.

Furthermore, watermark technology is used to track and verify proper delivery of content including advertising content. **In one application of this technology, recipients of advertising content, such as TV subscribers, computer users (identified users), are provided incentives for viewing advertising in its entirety. For example, a content-receiving device, such as a computer, can include a watermark detector that issues a receipt for each watermarked advertisement that is heard/viewed in its entirety (providing accrued incentives or accumulated rewards to an identified user of a computer or a set-top-box for listening to played or viewing displayed watermarked advertisements). These receipts may be redeemed, for example, for content tokens (type of currency), for monetary value, etc. In some embodiments, receipts are generic and can all be applied to a desired premium (such as access to content or otherwise), regardless of the advertisements through which they were earned. In other embodiments, the receipts are associated with the particular advertisers (or class of advertisers). Thus, an identified or a specific TV viewer who accumulates 50 receipts (accrued rewards) for hearing/viewing advertising originating from Procter & Gamble may be able to redeem them for a coupon good for $2.50 off any Procter & Gamble product, or accrued or accumulated receipts from Delta Airlines may be redeemed for Delta frequency flier miles (e.g., at a rate of one mile per minute of advertising heard/viewed). Such incentives are particularly useful in new forms of media that give the consumer enhanced opportunities to fast-forward or otherwise skip advertising (col. 57: 65 to col. 58: 34).**

(Col. 44: 17 to col. 45: 22; col. 24: 23-37; col. 54: 26-54; col. 55: 35 to col. 56: 19; col. 57: 9 to col. 58: 34).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6, 216, 112B1 to Fuller discloses a method and system for distributing free software, having advertisements embedded therein, to customers and compensating the authors of the software for every copy of the software illegally distributed by collecting payments from advertisers or sponsors whose advertising messages are inserted in the said software to be displayed on the customer's or user's PC screen. The software or application software, downloaded over the Internet from a web site related to a computer server 102 of fig. 1 or shipped to a user on a floppy disk or a CD ROM (Media player) to be installed on the user's PC 110 of fig. 1, is executed by the user on his PC 110 of fig. 1 subsequent to installing the software on his computer hard disk (See abstract; col. 2: 30-32). **Here, the user has restricted rights to the free software and thus, he must occasionally or periodically read advertising messages whenever he executes the said software or before using the software.**

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

08/12/06

JDJ

Jean D. Janvier

Patent Examiner

Art Unit 3622

JEAN D. JANVIER
PRIMARY EXAMINER